



UNITED STATES DEPARTMENT OF COMMERCE

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APPLICATION NUMBER 08/770,115	FILING DATE 02/13/97	ALLEGEMAN FIRST NAMED APPLICANT	ATTORNEY DOCKET NO. FAP-A-1479
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26M1/1114

MATTA A  
EXAMINER

JOHN P SUTTON  
BRYAN HINSHAW COHEN & BARNET  
425 CALIFORNIA STREET SUITE 900  
SAN FRANCISCO CA 94104

ART UNIT  
2601

PAPER NUMBER

119 14/97

DATE MAILED:

INTERVIEW SUMMARY

All participants (applicant, applicant's representative, PTO personnel):

(1) Krista Zele (3) John Sutton  
(2) Ahmad Matar (4) James Alleman

Date of Interview 11/4/97

Type:  Telephonic  Personal (copy is given to  applicant  applicant's representative).

Exhibit shown or demonstration conducted:  Yes  No If yes, brief description: \_\_\_\_\_

Agreement  was reached.  was not reached.

Claim(s) discussed: proposed new claims 1 and 2.

Identification of prior art discussed: articles used for 102(a) rejection.

Description of the general nature of what was agreed to if an agreement was reached, or any other comments: \_\_\_\_\_

See attachment.

(A fuller description, if necessary, and a copy of the amendments, if available, which the examiner agreed would render the claims allowable must be attached. Also, where no copy of the amendments which would render the claims allowable is available, a summary thereof must be attached.)

1.  It is not necessary for applicant to provide a separate record of the substance of the interview.

Unless the paragraph above has been checked to indicate to the contrary, A FORMAL WRITTEN RESPONSE TO THE LAST OFFICE ACTION IS NOT WAIVED AND MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a response to the last Office action has already been filed, APPLICANT IS GIVEN ONE MONTH FROM THIS INTERVIEW DATE TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW.

2.  Since the Examiner's interview summary above (including any attachments) reflects a complete response to each of the objections, rejections and requirements that may be present in the last Office action, and since the claims are now allowable, this completed form is considered to fulfill the response requirements of the last Office action. Applicant is not relieved from providing a separate record of the interview unless box 1 above is also checked.

Examiner Note: You must sign this form unless it is an attachment to another form.

## Manual of Patent Examining Procedure, Section 713.04 Substance of Interview must Be Made of Record

A complete written statement as to the substance of any face-to-face or telephone interview with regard to an application must be made of record in the application, whether or not an agreement with the examiner was reached at the interview.

### §1.133 Interviews

(b) In every instance where reconsideration is requested in view of an interview with an examiner, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the applicant. An interview does not remove the necessity for response to Office action as specified in §§ 1.111,1.135. (35 U.S.C.132)

§ 1.2. Business to be transacted in writing. All business with the Patent or Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

The action of the Patent and Trademark Office cannot be based exclusively on the written record in the Office if that record is itself incomplete through the failure to record the substance of interviews.

It is the responsibility of the applicant or the attorney or agent to make the substance of an interview of record in the application file, unless the examiner indicates he or she will do so. It is the examiner's responsibility to see that such a record is made and to correct material inaccuracies which bear directly on the question of patentability.

Examiners must complete a two-sheet carbon interleaf Interview Summary Form for each interview held after January 1, 1978 where a matter of substance has been discussed during the interview by checking the appropriate boxes and filling in the blanks in neat handwritten form using a ball point pen. Discussions regarding only procedural matters, directed solely to restriction requirements for which interview recordation is otherwise provided for in Section 812.01 of the Manual of Patent Examining Procedure, or pointing out typographical errors or unreadable script in Office actions or the like, are excluded from the interview recordation procedures below.

The Interview Summary Form shall be given an appropriate paper number, placed in the right hand portion of the file, and listed on the "Contents" list on the file wrapper. The docket and serial register cards need not be updated to reflect interviews. In a personal interview, the duplicate copy of the Form is removed and given to the applicant (or attorney or agent) at the conclusion of the interview. In the case of a telephonic interview, the copy is mailed to the applicant's correspondence address either with or prior to the next official communication. If additional correspondence from the examiner is not likely before an allowance or if other circumstances dictate, the Form should be mailed promptly after the telephonic interview rather than with the next official communication.

The Form provides for recordation of the following information:

- Serial Number of the application
- Name of applicant
- Name of examiner
- Date of interview
- Type of interview (personal or telephonic)
- Name of participant(s) (applicant, attorney or agent, etc.)
- An indication whether or not an exhibit was shown or a demonstration conducted
- An identification of the claims discussed
- An identification of the specific prior art discussed
- An indication whether an agreement was reached and if so, a description of the general nature of the agreement (may be by attachment of a copy of amendments or claims agreed as being allowable). (Agreements as to allowability are tentative and do not restrict further action by the examiner to the contrary.)
- The signature of the examiner who conducted the interview
- Names of other Patent and Trademark Office personnel present.

The Form also contains a statement reminding the applicant of his responsibility to record the substance of the interview.

It is desirable that the examiner orally remind the applicant of his obligation to record the substance of the interview in each case unless both applicant and examiner agree that the examiner will record same. Where the examiner agrees to record the substance of the interview, or when it is adequately recorded on the Form or in an attachment to the Form, the examiner should check a box at the bottom of the Form informing the applicant that he need not supplement the Form by submitting a separate record of the substance of the interview.

If should be noted, however, that the Interview Summary Form will not normally be considered a complete and proper recordation of the interview unless it includes, or is supplemented by the applicant or the examiner to include, all of the applicable items required below concerning the substance of the interview:

A complete and proper recordation of the substance of any interview should include at least the following applicable items:

- 1) A brief description of the nature of any exhibit shown or any demonstration conducted,
- 2) an identification of the claims discussed,
- 3) an identification of specific prior art discussed,
- 4) an identification of the principal proposed amendments of a substantive nature discussed, unless these are already described on the Interview Summary Form completed by the examiner,
- 5) a brief identification of the general thrust of the principal arguments presented to the examiner. The identification of arguments need not be lengthy or elaborate. A verbatim or highly detailed description of the arguments is not required. The identification of the arguments is sufficient if the general nature or thrust of the principal arguments made to the examiner can be understood in the context of the application file. Of course, the applicant may desire to emphasize and fully describe those arguments which he feels were or might be persuasive to the examiner,
- 6) a general indication of any other pertinent matters discussed, and
- 7) if appropriate, the general results or outcome of the interview unless already described in the Interview Summary Form completed by the examiner.

Examiners are expected to carefully review the applicant's record of the substance of an interview. If the record is not complete or accurate, the examiner will give the applicant one month from the date of the notifying letter or the remainder of any period for response, whichever is longer, to complete the response and thereby avoid abandonment of the application (37 CFR 1.135(c)).

### Examiner to Check for Accuracy

Applicant's summary of what took place at the interview should be carefully checked to determine the accuracy of any argument or statement attributed to the examiner during the interview. If there is an inaccuracy and it bears directly on the question of patentability, it should be pointed out in the next Office letter. If the claims are allowable for other reasons of record, the examiner should send a letter setting forth his or her version of the statement attributed to him. If the record is complete and accurate, the examiner should place the indication "Interview record OK" on the paper recording the substance of the interview along with the date and the examiner's initials.

Art Unit: 2601

Supervisory Primary Examiner Zele and Primary Examiner Matar informed Applicant that the 131 declaration (paper # 5, filed 6/18/97) appears to lack sufficient evidence to overcome the prior art of record rejecting the claimed invention. Applicant and his representative were directed to MPEP sections 715.02 and 715.07 for examples of supporting facts and documentary evidence that should be submitted to support Applicant's allegation of reduction to practice prior to June 27, 1990. It was also discussed that paragraph 6 of Applicant's declaration (paper #5, filed 6/18/97) states that the invention was not compatible with telephone equipment and that Mr. Gunther was requested to write software to make the invention compatible with the telephone equipment. Paragraph 23 of the same declaration indicates that this software was completed by Mr. Gunther in September, 1990 (after the alleged date of reduction to practice). Paragraph 24 of the declaration states that the needed hardware was "completed" by Call Interactive on April 25, 1991 (after the alleged date of reduction to practice).

Applicant and his representative stated that the software added after June 27, 1990 by Mr. Gunther was for less important add-on features which are not recited in the independent claims. Also, Applicant and his representative asserted that the factual statements that the invention was non-functional and was not reduced to practice until April 25, 1991 (131 declaration in parent application) were prepared by a previous representative to discuss diligence and are in error. Clarification of the record in this application was requested.

Art Unit: 2601

Applicant submitted two proposed new claims which recite the use of the Direct Inward Dialing DID feature (see attachment). Examiner Matar stated that proposed claims 1 and 2 appeared to overcome (1) the rejection under 35 USC 102(b) over Kahn alone and (2) the rejection under 35 UCS 103(a) over the combination of only Kahn and Billinger. Examiner informed Applicant that the terminology “basic international callback” has no antecedent basis in Applicant’s specification and has not been specifically defined by Applicant.

Applicant stated that claims reciting the use of the Direct Inward Dialing DID are not anticipated by the IDT machine as described in one or more of the cited articles and pages 3 and 4 of Applicant’s specification. Applicant stated that he would explain, on the record, in his next response how the above IDT machine differs from the claims which recite the use of the DID. Examiner Matar stated that he will consider withdrawing the 102(a) rejection in view of Applicant’s arguments. It was also discussed that if the use of DID in the IDT machine were not inherent (35 UCS 102), the issue regarding the obviousness of using the DID in the IDT machine (35 USC 103) would have to be determined.

Applicant questioned the use of Examiner’s Exhibit B which contains references having a publication date later than the effective filing date of this application. Examiner Matar explained that Exhibit B was not used as a base or teaching reference in the 103 rejection, but rather as evidence showing the “skill level in the art at the time the invention was made”. See *Ex parte Erlich*, 22 USPQ2d 1463 (BPAI 1992) and *Gould v. Quigg* 3 USPQ2d 1302 (Fed. Cir. 1987) which were cited by Examiner in the previous Office action. The teachings are

Art Unit: 2601

provided by the prior art references. Specifically, **Kahn** teaches the callback feature and **Curtin** teaches the use of Direct Inward Dialing for identifying the calling party as discussed in detail in the previous Office action. Exhibit B, which is not technically prior art, is used to show that one of ordinary skill in the art, at the time the invention was made, would have had ample motivation to combine the DID feature taught by **Curtin** in the callback system taught by **Kahn**. Copies of the above-mentioned cases are now provided by Examiner for Applicant's convenience.

At the conclusion of the interview, Applicant was invited to phone the Examiner for questions or suggestions which may help expedite the prosecution of this application.



AHMAD F. MATAR  
PRIMARY EXAMINER  
GROUP 2600



KRISTA ZELE  
SUPERVISORY PATENT EXAMINER

## PROPOSED NEW CLAIMS

The second office action criticizes the response to the first office action as not addressing the present claims, which differ from the amended claims in the case on appeal. Specifically, the claims on appeal were all limited to "direct inward dialing," and the present claims were not all so limited. Rather than attempting to amend the claims as they are in the appealed case, or amending the claims as originally presented in the appealed case, applicant believes it would be more productive to try to reach agreement on just two proposed new claims, then amend as needed. In addition to DID, the examiner has suggested that the claims should be limited to "international callback" or "basic international callback" as the system has come to be known. It is important not to have claims that read on ANI, an identification system not related to the present invention. Finally, terms like "automatic" and "without human intervention" are used in the literature describing basic international callback, to distinguish from operator assisted or central station supervision in calling.

Applicant has sought to incorporate all of these ideas in the following two claims:

1. A system for low cost basic international callback using a callback station in the United States, comprising a) a control device at the callback station for dialing a callback number on a first line in response to a direct inward dial signal from a subscriber to the system, who may be located in a jurisdiction having higher long distance telephone rates than the rates prevailing at the callback station, b) automatic dialing equipment at the callback station for calling back the subscriber at his designated callback number, c) automatic switching equipment for bridging the first line on the callback line to a second line dialed by the subscriber to a called party, who may be in a jurisdiction having higher telephone rates than those prevailing in the United States, whereby the subscriber is telephonically linked to the called party without human intervention at the callback station.
2. A method for basic international callback for low cost international calls comprising a) a subscriber dials a processor on a direct inward dial line assigned to the subscriber, and hangs up after a predetermined interval, the processor automatically calls the subscriber back at a preassigned telephone number on a first carrier line, the subscriber dials in the telephone number of the called party, the processor calls the called party on a second carrier line, and the processor automatically bridges the first and second lines to telephonically link the subscriber and the called party.